

REMARKS

This amendment is responsive to the Office Action dated November 5, 2004. Claims 1, 2 and 4 - 14 are pending in this application and have been rejected. Reexamination is respectfully requested in view of the amendments in the claims and the following remarks.

These remarks follow the order of the outstanding Office Action beginning at page 2.

Claim Rejections - 35 USC § 112

Claims 1, 2, 4 and 12 have been rejected under 35 USC § 112 second paragraph. The Examiner relies upon MPEP § 2172.01. This rejection is necessarily based upon that portion of the statute (35 USC § 112 second paragraph) which requires Applicant to claim subject matter which Applicant regards as his invention. See In re Mayhew 527 F.2d.1229, 188 USPQ 356 (CCPA 1976). In the Mayhew decision, the initial portion is directed to 35 USC § 112 paragraph one. This is the portion which relates to an enabling disclosure. This has not been stated to be a part of the rejection herein. In the concurring opinion by Judge Baldwin, there is found the portion of the opinion that relates to 35 USC § 112 second paragraph. A copy of the Mayhew decision is attached hereto for the Examiner's convenience.

In the portion of the opinion relating to 35 USC § 112 second paragraph (see 188 USPQ page 361), the Court states that the burden of proof is on the Patent Office to demonstrate that the claims do not comply with 35 USC § 112 second paragraph. Here, the Examiner has done nothing to meet the burden of proof to show that Applicant's claimed invention is not in accordance with what Applicant regards the invention to be which is the standard of 35 USC § 112 second paragraph. The Examiner cites MPEP § 2172.01 as support for the rejection. However, the first paragraph of this portion of the MPEP makes cross reference to MPEP § 2164.08<sup>©</sup>). This section of the MPEP also considers the Mayhew decision and states that in determining whether an unclaimed feature is critical, the entire disclosure must be considered. It states that features which are merely preferred are not to be considered critical. It further states that broad language in the disclosure including the Abstract omitting an allegedly critical feature tends to rebut the argument for criticality. Applicant has amended the independent claims to include the steps of filtering, distillation and collecting in order to comply with this rejection.

#### Inert Gas

Here the Examiner has not cited Applicant's specification to support any criticality in one of the steps enumerated at lines 10 and 11 of page 2 of the Office Action, namely the inert gas. On the other hand, Applicant's Abstract, Applicant's

initially filed claims, and disclosure of the invention as found in paragraphs [0004] - [0006], [0008], [0009] [0010] [0019] do not support the contention that Applicant regards the invention as narrowly as the Examiner would assert. Applicant's working examples 1 to 6 mention nitrogen (an inert gas), but it is possible to use another medium or gas. The amended claims agree with paragraph [0019] which states that the introduction of inert gas is more suitable. On the other hand, the Examiner has made no observation in the specification at all as to why Applicant should be so limited in the claims at issue.

The Examiner has alluded to prior art distinctions. If there are prior art distinctions, there should be rejections based upon the prior art, and not a mere assertion that there may be prior art. Applicant cannot respond to prior art which is not specifically explained and cited.

As explained by Judge Baldwin in In re Mayhew 188 USPQ page 362, second column,

"...a claim is considered to particularly point out and distinctly claim the subject matter which the appellant regards as his invention unless appellant has otherwise indicated that he intends the claims to be of a different scope. As can be seen from the passages quoted from appellant's specification, supra, appellant regards his invention to be practicable only by inclusion of a cooling zone specially located."

The Examiner has cited nothing in the outstanding rejection which would point to portions of Applicant's specification which require the specification to be interpreted as the Examiner asserts. The Examiner refers to the working examples. However,

the Examiner has ignored the manufacturing methods of the fragrant wood extract beginning at page 17 of the specification. Here at paragraph [0049], there is no inert gas.

Applicant's Claim 1

Applicant's claim 1 has now been amended to overcome rejections under 35 USC § 112 second paragraph found at page 4. In claim 1 as now amended, Applicant has clearly recited the three steps of this invention, including the last step of collecting the fragrance liquid in an absorption solvent. Applicant has eliminated the preamble problem discussed at page 3, lines 1 - 3.

Claim Rejections - 35 USC § 102/103

Bedoukian

Claims 5 - 7, 9 - 11, 13 and 14 have been rejected as either being anticipated by or, in the alternative, obvious over '096 to Bedoukian.

This rejection is respectfully traversed on the grounds that the Bedoukian process, while extracting an oil from wood, does not extract the oil in a manner which will pass over to the perfume component all of the components of the wood in a manner like Applicant. As explained by '096 with respect to the examples (column 3, lines 55 - column 4, line 21), wood is initially mixed with a toluene. The next step involves obtaining an extract by passing the batch through a filter for removal of

cedar wood sawdust. Next, there is a first distillation step where the toluene is removed. This produces a produces a purified extract which is then vacuum distilled to obtain a light cedar wood oil. The end product in '096 is the light cedar wood oil. The extract procedure used toluene, and in all events uses a water insoluble solvent (column 3, lines 32 - 37). On the other hand, Applicant utilizes a solvent which allows collection in vapor phase by heating the extract as claimed. Applicant's solvent allows vapor of the extract to pass over while retaining the solvent as shown in Figure 1. Just the opposite occurs in '096 where the fragrance is retained, and the more volatile solvent passes over. Considering this difference, it is clear that Applicant's process will extract different components of the aromatic oils from the wood than will that of '096. Therefore, it is respectfully submitted that the product of '096 cannot be that of Applicant's claim 1. Stated another way, the product of '096 will necessarily contain different wood components as it is refined differently, and is further refined in the step of purification of the extract prior to obtaining the final light colored cedar oil which is the object of that process.

Diagram "A" shows the Applicant's claimed invention where the volatile components removed from the fragrance ingredient and collected in the fragrance collection liquid (last 2 steps of Diagram "A").

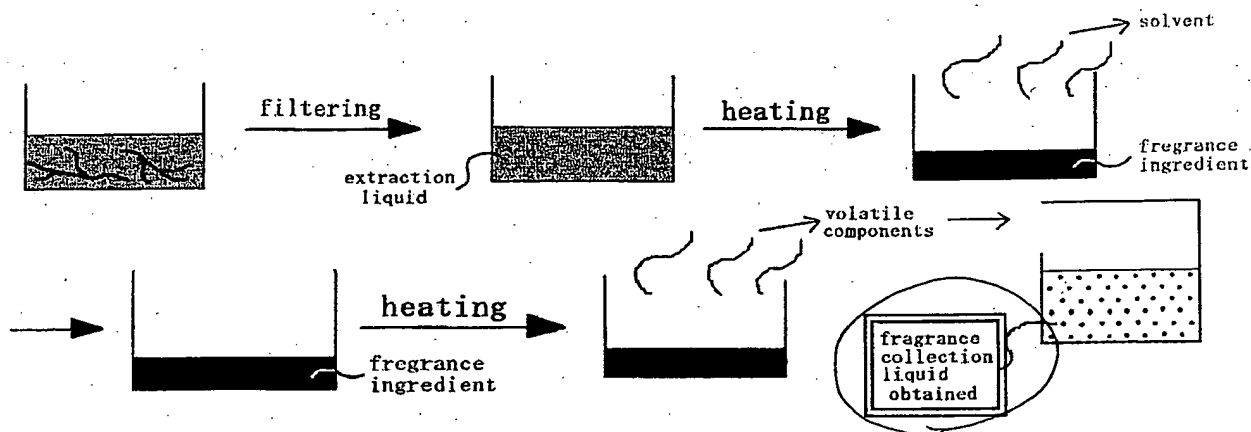
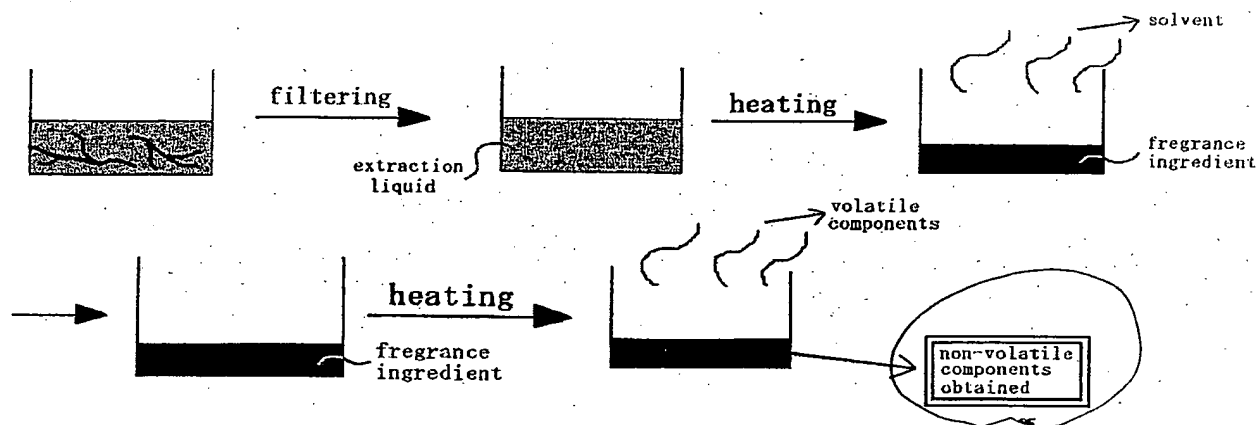


Diagram "B" shows the steps of 4,920,096 (Bedoukian) whose last steps remove the volatile components and allow non-volatile components to remain. This is described in claim 8 and column 4, lines 3 - 8 of '096. The difference is clear, Applicant captures what '096 throws away.



#### Nagashima

Claims 5 - 11, 13 and 14 have been rejected as being anticipated by, or in the alternative obvious over '982. This rejection is respectfully traversed for the reasons which follow.

The Examiner argues that the patentability of the product does not depend upon the method of production. However, it is respectfully submitted that the product must be the same in order for this rejection to be sustainable. Specifically, Applicant respectfully submits that the Examiner has not shown that the perfume of '982 is the same as the perfume which would be produced by Applicant's claimed process found in claims 1 - 4 which are in turn incorporated into the product claims rejected herein. The '982 patent does not provide a fragrance which is in accordance with Applicant's claim 4, much less in accordance with Applicant's claim 1. '982 first recognizes that agar wood has long been famous as a natural perfume. Then the reference continues at the bottom of column 1 to note the presence of formula VI. The reference then continues to state at column 2, lines 10 - 20 that the inventor found that one of the important compounds which provides the scent of agar wood. The inventor then goes on to discuss and claim a particular formula (formula I) or formula (II) as a material which can be synthesized.

This reference does not disclose obtaining agar wood perfume odors from agar wood which would necessarily include all of the minor constituencies of agar wood. It only discloses an extract component (Formula I, Formula II) of agar wood which could then be used in a perfume. Therefore, it does not in any way disclose a product which can be said to be like that obtained by Applicant's claim 1 which is dependent upon direct extraction from the tree by the claimed steps. For this reason, the

Examiner's rejection on a product by process theory is not correct. The reason is that the product (Formula I, Formula II) of '982 is simply not the same as the product produced by Applicant's process. Therefore, when the two different products are added to perfumes, different perfumes result.

Mookherjee et al.

The rejection of claims 5, 6, 7, 9 - 11, 13 and 14 under 35 USC § 102(b) as being anticipated by Mookherjee and the rejection of claim 8 as being unpatentable over Mookherjee in view of Nagashima is respectfully traversed. The Mookherjee '006 reference does not disclose a process or a perfume composition which is the same as that produced by Applicant's claimed process in Applicant's product by process claims.

'006 teaches a method of producing a perfume such as those disclosed in Table 2, column 22. These perfumes, however, are not perfumes which are created by a process of extracting an essential oil, collecting the fragrance ingredient in vapor phase and then collecting in an absorption solvent. Instead, the fragrances taught by '006 are simulations of an actual fragrance.

As taught by the Abstract, this is a process for producing flavor and fragrance compositions by means of first quantitatively and qualitatively analyzing an aroma. Such analysis is taught in Figure 4, various components of an aroma are analyzed. The aroma analyzed is best illustrated by Example I and Table I (column 20), there is a long list of the materials

found in the Douglas Fir tree headspace analysis. However, referral to Table I shows that only a few of the components are of any real significance. These components are listed in Examples II, III and IV found in column 21. In the Examples such as Example II the numbers agree with the large numbers found in Table I. '006 teaches that as a result of the analysis of Table I, a fragrance formulation was prepared using just the major components of the interior analysis. The fragrance resulting is one that is made in accordance with the formula, not one which is used to determine the formulation. Stated another way, there is provided at least the major aroma components found in at least one of the analysis and admixing of the resulting components to form a fragrance composition or flavor composition (see Abstract).

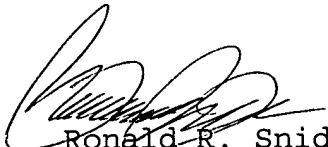
This teaches that not all components of the fragrance composition extracted from the tree are used to construct the perfume. On the other hand, as Applicant teaches and claims, everything in the material extracted from the tree and which is collected ultimately becomes a fragrance ingredient which is collected in vapor phase, and then, in turn, collected in a fragrance ingredient absorption solvent (claim 1). Another way to view the difference between Applicant's claims and '006 is to note that '006 never places the content of the entire group of materials listed in Table I, column 20 in a solvent be it alcohol or any other absorption-type solvent. Once the chemical analysis is done, as depicted in Figures 4A and 4B, the resultant analysis

yields the information which is shown in Examples II, III and IV (column 21), and there is no further use of the beginning components originally taken from the tree.

Therefore, '006 simply does not teach a true fragrance which contains all components which are obtained in accordance with Applicant's claimed process which is used to create the fragrance collection liquid of claim 5 which is collected in accordance with claim 1.

It is respectfully submitted that the application is now in condition for allowance, and early action in accordance thereof is requested. In the event there is any reason why the application cannot be allowed in this current condition, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems by Interview or Examiner's Amendment.

Respectfully submitted,



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